

REMARKS

Reconsideration of this application, in view of the following remarks, is respectfully requested.

The following rejections and requirements were set forth in the Office Action:

1. A requirement has been made for the submission of articles cited in an information disclosure statement;
2. Claims 1, 4, 5 and 7 stand rejected under 35 USC §103 as being unpatentable over U.S. Patent No. 6,068,394 to Dublin in view of U.S. Patent No. 5,334,801 to Mohn;
3. Claims 2 and 3 stand rejected under 35 USC §103 as being unpatentable over Dublin in view of Mohn and further in view of U.S. Patent No. 6,288,975 to Frederick, et al.; and
4. Claims 6 and 8 stand rejected under 35 USC §103 as being unpatentable over Dublin in view of Mohn and further in view of U.S. Patent No. 6,199,629 to Shirk, et al.

Enclosed herewith are the three articles listed in the form PTO-1449 submitted with the previously filed information disclosure statement. Apparently these articles are missing from the Patent Office database or were not scanned in with the information disclosure statement.

Regarding the obviousness rejections of claims 1, 4, 5 and 7, these rejections are respectfully traversed. Please note that claim 1 requires that a tubular body include a sidewall material, that a line is embedded in the sidewall material, and that a sensor is embedded in the sidewall material. The claim does not merely require the line and

sensor to be within the sidewall. Instead, the claim specifically requires the line and sensor to be embedded in the sidewall material.

The dictionary definition of the term “embed,” and as understood to those skilled in the art, is “to fix an object firmly and deeply in a surrounding mass.” In the present case, the line and the sensor are required to be embedded in a specific material.

In contrast, the sensor 48 of Dublin is merely attached to a diaphragm 32 formed from a sidewall material of a sensor sub 20. In Mohr, the conductor 10 is positioned in a groove 11 formed in a pipe 2. A liner 15 isolates the conductor 10 from the interior passage of the pipe 2.

It will be appreciated that these references do not describe the elements and limitations recited in claim 1. For at least this reason, the examiner is respectfully requested to withdraw the obviousness rejections of claims 1, 4, 5, 7, and of their dependents.

In addition, a *prima facie* case of obviousness has not been made out for any of claims 1, 4, 5 and 7, since there is no motivation or suggestion in either of the Dublin or Mohr references to make the combination proposed by the examiner. As stated in the MPEP §§2143, 2143.01,

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

In addition, neither of the references describes or suggests how the conductors 10 of Mohr could be connected to the sensor 48 of Dublin, since the Mohr conductors are only described as extending between end connections of the pipe 2. The Dublin sensor 48 is positioned in a passage 30 which is purposely isolated from both the interior and exterior of the sensor sub 20. Significant structural problems would need to be

overcome in order to make the combination proposed by the examiner. The solution to these problems is not described in either Dublin or Mohr. Instead, a solution is found in the applicants' specification.

Therefore, the applicants respectfully submit that a *prima facie* case of obviousness has not been shown for claims 1, 4, 5 and 7, and the examiner is respectfully requested to withdraw the rejections of these claims and their dependents.

In view of the foregoing remarks, all of the claims pending in this application are now seen to be in a condition for allowance. A Notice of Allowance of claims 1-8 is therefore earnestly solicited.

The examiner is hereby requested to telephone the undersigned attorney of record at (972) 516-0030 if such would expedite the prosecution of the application.

Respectfully submitted,

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Dated: November 30, 2005

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450,

on Dec. 1, 2005
Sherry Duffee